

REMARKS

Claims 1 – 87 and 89 – 107 are pending in the application and are presented for reconsideration and further examination in view of the following remarks. Claim 88 has been cancelled and claims 96 – 107, which are allowable claims rewritten in independent form, have been newly added.

In the outstanding Office Action the Examiner rejected claims 1 – 3, 5 – 9, 11 – 14, 16 – 20, 22 – 25, 27 – 31, 33 – 36, 38 – 42, 44 – 47, 49 – 53, 55 – 58, 60 – 64, and 66 – 86 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,768,426 to Rhoads (hereinafter referred to as “the Rhoads ‘426 patent” or “Rhoads”); rejected claims 87 – 90 and 92 – 95 under 35 U.S.C. §103(a) as being unpatentable over the Rhoads ‘426 patent in view of U.S. Patent No. 4,981,370 to Dziewit et al. (hereinafter referred to as “the Dziewit et al. ‘370 patent” or “Dziewit”) and further in view of U.S. Patent No. 4,467,139 to Mollier (hereinafter referred to as “the Mollier ‘139 patent” or “Mollier”); and rejected claim 91 under 35 U.S.C. §103(a) as being unpatentable over the Rhoads ‘426 patent in view of the Dziewit et al. ‘370 patent, further in view of the Mollier ‘139 patent and further in view of U.S. Patent No. 5,677,955 to Doggett et al. (hereinafter referred to as “the Doggett et al. ‘955 patent” or “Doggett”); and objected to claims 4, 15, 26, 37, 48, and 59 as being dependent on a rejected base claim but indicated that these claims would be allowable if rewritten in independent form.

By this Response and Amendment,

all of the independent claims have been amended to recite “sensible component containing information *making discernable* copying or modification of said printed document in a copy or modified version of said printed document *for authenticating said original document in said original form;*”

each of independent claims 1 and 23 content of an original document in electronic form,
the original document being in an original form;"

claim 12 has been amended to recite "rendered content of an original document, *the original document being in an original form;*"

each of independent claims 34, 45, and 56 has been amended to recite "means for generating a content digest for an original document, *the original document being in an original form;*"

each of independent claims 69, 75, 81 and 87 has been amended to recite "said authenticating document including content of an original document, *the original document being in an original form;*"

claim 88 is cancelled;

claims 96 – 107 are newly added;

Support for all of the above amendments to the independent claims can be found on page 30, lines 1 – 15. Therefore, it is respectfully submitted that no new matter within the meaning of the 35 U.S.C. §132 has been added to the present application.

Rejections Under 35 U.S.C. §102(b)

The Examiner rejected claims 1 – 3, 5 – 9, 11 – 14, 16 – 20, 22 – 25, 27 – 31, 33 – 36, 38 – 42, 44 – 47, 49 – 53, 55 – 58, 60 – 64, and 66 – 86 as being anticipated by the Rhoads '426 patent. In paragraph 5 of the Office Action, the Examiner asserted that "Applicant's argument [of July 14, 2004] that the Rhoads reference does not disclose authenticating said original document in original form is not persuasive because claims 1, 12, 23, 34, 45, 56, 69, 75 and 81 do not include the limitation 'authenticating said original document in original form'."

Response

By this Response and Amendment, each of claims 1, 12, 23, 34, 45, 56, 69, 75, 81 and 87 has been amended to include the phrase “for authenticating said original document in said original form.”

As the Examiner has indicated that the Applicants arguments in favour of the patentability of claims 1, 12, 23, 34, 45, 56, 69, 75, and 81 is not persuasive *because* the claims do not include the limitation ‘authenticating said original document in original form,’ whereas this feature has now been added to each of the independent claims, Applicants assert that the argument that the Rhoads reference does not disclose authenticating said original document in original form *is* persuasive.

Rhoads describes a method, which impresses an identification code signal on a carrier to be identified (such as an electronic data signal or a physical medium) in a manner that permits the identification signal later to be discerned and the carrier thereby identified. The method and apparatus are characterised by robustness despite degradation of the encoded carrier, and by holographic permeation of the identification signal throughout the carrier, e.g. an identification code number is distributed in a largely integral form throughout an encoded signal or image. The verification process can be applied to printed document by scanning the document back to its digital form.

Contrastingly, independent claims 1, 12, 23, 34 45, 56, 69, 75, 81 and 87 now include the limitations that the optically sensitive or sensible component contains information making discernible copying or modification of said printed document in a copy or modified version of said printed document, and that the electronic seal or e-seal is for authenticating said original

document in electronic form and in original form. Applicants respectfully submit that at least these features are not disclosed in the cited prior art.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejections.

Rejections Under 35 U.S.C. §103(a)

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

1. The Rhoads ‘426 patent, the Dziewit et al. ‘370 patent, and the Mollier ‘139 patent

The Examiner rejected claims 87 – 90 and 92 – 95 as being unpatentable over the Rhoads ‘426 patent in view of the Dziewit et al. ‘370 patent and further in view of the Mollier ‘139 patent.

Response

Applicants respectfully disagree and therefore traverse the rejections. The arguments above with respect to the patentability of the independent claims over the Rhoads ‘426 patent are hereby incorporated by reference.

The Dziewit et al. ‘370 patent and the Mollier ‘139 patent do not account for the deficiencies of the Rhoads ‘426 patent. Dziewit et al. relates to a system for allowing two parties

to sign a contract simultaneously using digital signatures, for which purpose the origin of the documents is not so relevant as the identity between the two documents. Mollier relates to the transmission of signed messages. However, the Examiner has not shown where either of these references teaches or suggests a “sensible component containing information *making discernable* copying or modification of said printed document in a copy or modified version of said printed document *for authenticating said original document in said original form*” as recited in each of the independent claims.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections.

2. The Rhoads ‘426 Patent, The Dziewit Et Al. ‘370 Patent, The Mollier ‘139 Patent, And The Doggett ‘955 Patent

The Examiner rejected claim 91 under 35 U.S.C. 103(a) as being unpatentable over Rhoads in view of Dziewit et al. further in view of Mollier and further in view of Doggett.

Response

Applicants respectfully disagree and therefore traverse the rejections. The arguments above with respect to the patentability of the independent claims over the Rhoads ‘426 patent, the Dziewit et al. ‘370 patent and the Mollier ‘139 patent are hereby incorporated by reference.

The Doggett ‘955 patent does not account for the deficiencies of the other references. The Doggett ‘955 patent discloses an electronic instrument for affecting a transfer of funds from an account of a payer in a funds-holding institution to a payee. The electronic instrument includes an electronic signature of the payer, digital representations of payment instructions, the identity of the payer, the identity of the payee, and the identity of the funds-holding institution.

A *digital* representation of a verifiable certificate by the institution of the authenticity of the instrument is appended to the instrument. This enables a party receiving the instrument, e.g., the payee or a bank, to verify the authenticity of the account or account holder. However, the Examiner has not shown where the Doggett '955 patent teaches or suggests a "sensible component containing information *making discernable* copying or modification of said printed document in a copy or modified version of said printed document *for authenticating said original document in said original form*" as recited in each of the independent claims.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections.

MISCELLANEOUS

Claims 96 – 107 are newly added. Applicants assert that these claims are patentable over the cited prior art references as they include the features of claims 4, 15, 26, 37, 48 and 59, which the Examiner has indicated as being allowable and claims 10, 21, 32, 43, 54, and 65, which the Examiner indicated as not being rejected by any prior art reference.

CONCLUSION

In view of the above remarks Applicants submit that none of the claims is rendered unpatentable on the basis of the prior art as cited. Applicants therefore ask that the Examiner withdraw his claim rejections and issue a notice of allowance in the near future.

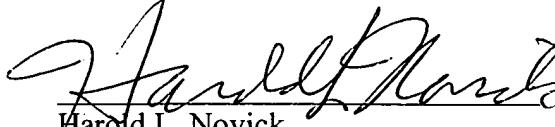
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Respectfully submitted,

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